

REMARKS

Claims 6-36 were pending and presented for examination and in this application. In an Office Action dated November 13, 2008, claims 6-36 were rejected. Applicants thank the Examiner for examination of the claims pending in this application and address the Examiner's comments below. Based on the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

Summary of Interview

Applicants thank Examiner Kieu D. Vu for the Examiner interview on January 13, 2009. During the interview, Applicants' representatives, Jennifer Bush and Edgar Perez discussed with the Examiner the rejection under § 102(e). The Examiner agreed that the amendments to claims 6 and 25 make the claims distinguishable over the cited reference. Additionally, the Examiner indicated that amendments to claims 6 and 25 would not be entered because they require a new search. The arguments set forth in the interview are summarized below.

Response to Rejection Under 35 U.S.C. § 102(e)

In the 3rd and 4th paragraphs of the Office Action, the Examiner rejects claims 6, 7, 17, 18, 25, 26, 35, and 36 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,237,010 ("Hui"). This rejection is now traversed.

Claim 6 as amended recites, *inter alia*, a method for creating a representation, the method comprising:

capturing an image of a first object, the first object associated with a first software application;
determining a reference to the first object;
creating a second object associated with a second software application and an image of the second object, the second software application being distinct from the first software application;
creating a reference marker, the reference marker graphically connecting a location in the image of the second object with a location in the image of the first object;
creating the representation, the representation comprising the captured image, the determined reference, the image of the second object, and the reference marker; and
adding the representation to a message.

A benefit of the claimed invention is that it allows the creation of a visual representation that connects locations in two object images. The connection allows a user to visually detect the association between the first and second objects. Support for claim 6 is found throughout the specification, e.g., at paragraphs 58-60.

The cited reference does not disclose or suggest these aspects of the claimed invention. Specifically, Hui fails to disclose “creating a reference marker, the reference marker graphically connecting a **location** in the image of the second object with a **location** in the image of the first object.” In the rejection of claim 6, the Examiner cites col. 15, lines 32-45 in an attempt to show that Hui discloses the previously claimed reference marker. This section of Hui discloses that an audio file from window 144 of Fig. 18 can be selected for image 107 of Fig. 18.

The Examiner thus asserts that the image of the second object corresponds to an audio file in window 144, the image of the first object corresponds to image 107, and the reference marker corresponds to *highlighting* that occurs when the audio file is selected. This assertion is incorrect. By the audio file being highlighted a **location** in the audio file is **not** being connected to a **location** in image 107. The highlighting shows that the entire audio file is

being added to the image 107. *See* Hui, col. 15, ll. 47-50. Thus, Hui does not disclose creating a reference marker as claimed.

Accordingly, Applicants submit that claim 6 is patentably distinguishable over the cited reference. Claim 25 includes similar limitations as claim 6 and is therefore patentably distinguishable over the cited reference for at least the same reasons. Applicants respectfully request that the Examiner withdraw the rejection of claims 6 and 25.

Dependent claims 7, 17, 18, 26, 35, and 36 incorporate the limitations of their respective base claims. Applicants submit that claims 7, 17, 18, 26, 35, and 36 are allowable for at least the reasons described above, in addition to the further patentable limitations recited therein.

Response to Rejection Under 35 U.S.C. § 103(a)

In the 6th paragraphs the Examiner rejects claims 8, 10, 12, 14-16, 27, 29, 30, and 32-34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hui and U.S. Patent No. 6,404,441 (“Chailleux”). This rejection is now traversed.

Claims 8, 10, 12, 14-16, 27, 29, 30, and 32-34 variously depend from claims 6 and 25, which were shown above to be patentably distinct over Hui. Chailleux does not remedy the above-stated deficiencies of Hui, nor does the Examiner assert that it does. Chailleux merely discloses a system for producing presentations of computer application programs. *See* Chailleux, col. 3, ll. 27-28. There is no hint, mention or suggestion in Chailleux of “creating a reference marker, the reference marker graphically connecting a location in the image of the second object with a location in the image of the first object.”

Thus, the cited references fail to show all of the claimed elements and thus the Examiner has not met his burden in establishing a prima facie case of obviousness under 35 U.S.C. § 103(a). Accordingly, Applicants submit that claims 8, 10, 12, 14-16, 27, 29, 30, and 32-34 are patentable over Hui and Chailleux, alone or in the combination suggested by the Examiner, by reason of their dependency and the further limitations recited therein.

In the 7th paragraph the Examiner rejects claims 19 and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hui and U.S. Patent No. 6,278,829 (“Anguilo”). This rejection is now traversed.

Claims 19 and 20 depend from claim 6, which was shown above to be patentably distinct over Hui. Anguilo does not remedy the above-stated deficiencies of Hui, nor does the Examiner assert that it does. Anguilo merely discloses creating thumbnail representations of original, full-size images. *See* Anguilo, col. 5, ll. 61-65. There is no hint, mention or suggestion in Anguilo of “creating a reference marker, the reference marker graphically connecting a location in the image of the second object with a location in the image of the first object.”

Thus, the cited references fail to show all of the claimed elements and thus the Examiner has not met his burden in establishing a prima facie case of obviousness under 35 U.S.C. § 103(a). Accordingly, Applicants submit that claims 19 and 20 are patentable over Hui and Anguilo, alone or in the combination suggested by the Examiner, by reason of their dependency and the further limitations recited therein.

In the 8th paragraph the Examiner rejects claims 9 and 28 as allegedly being unpatentable under 35 U.S.C. § 103(a) over Hui and U.S. Patent No. 5,886,274 (“Jungleib”). This rejection is now traversed.

Claims 9 and 28 variously depend from claims 6 and 25, which were shown above to be patentably distinct over Hui. Jungleib does not remedy the above-stated deficiencies of Hui, nor does the Examiner assert that it does. Jungleib merely describes a system for composing a playing back musical works. *See* Jungleib, col. 1, ll. 53-54. There is no hint, mention or suggestion in Jungleib of “creating a reference marker, the reference marker graphically connecting a location in the image of the second object with a location in the image of the first object.”

Thus, the cited references fail to show all of the claimed elements and thus the Examiner has not met his burden in establishing a prima facie case of obviousness under 35 U.S.C. § 103(a). Accordingly, Applicants submit that claims 9 and 28 are patentable over Hui and Jungleib, alone or in the combination suggested by the Examiner, by reason of their dependency and the further limitations recited therein.

In the 9th paragraph the Examiner reject claim 11 as allegedly being unpatentable under 35 U.S.C. § 103(a) over Hui, Chailleux, and Jungleib. This rejection is now traversed.

Claim 11 depends from claim 6, which was shown above to be patentably distinct over Hui. As discussed above, neither Chailleux nor Jungleib remedy the above-stated deficiencies of Hui, nor does the Examiner assert that it does.

Thus, the cited references fail to show all of the claimed elements and thus the Examiner has not met his burden in establishing a prima facie case of obviousness under 35

U.S.C. § 103(a). Accordingly, Applicants submit that claim 11 is patentable over Hui, Chailleux, and Jungleib, alone or in the combination suggested by the Examiner, by reason of their dependency and the further limitations recited therein.

In the 10th paragraph the Examiner rejects claims 13, 21-24, and 31 as allegedly being unpatentable under 35 U.S.C. § 103(a) over Hui and U.S. Patent No. 6,091,408 (“Treibitz”). This rejection is now traversed.

Claims 13, 21-24, and 31 variously depend from claims 6 and 25, which were shown above to be patentably distinct over Hui. Treibitz does not remedy the above-stated deficiencies of Hui, nor does the Examiner assert that it does. Treibitz merely describes a system for organizing and displaying information. *See* Treibitz, col. 2, ll. 64-65. There is no hint, mention or suggestion in Treibitz of “creating a reference marker, the reference marker graphically connecting a location in the image of the second object with a location in the image of the first object.”

Thus, the cited references fail to show all of the claimed elements and thus the Examiner has not met his burden in establishing a prima facie case of obviousness under 35 U.S.C. § 103(a). Accordingly, Applicants submit that claims 13, 21-24, and 31 are patentable over Hui and Treibitz, alone or in the combination suggested by the Examiner, by reason of their dependency and the further limitations recited therein.

Conclusion

In sum, Applicants respectfully submit that claims 6-36 as presented herein, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,

Date: February 10, 2009

By: /Edgar Perez/
Patent Agent for Assignee
Edgar Perez, Reg. No. 63,348
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041
Phone: (650) 335-7821
Fax: (650) 938-5200